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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,406	11/20/2003	Naoki Yoshie	018775-887	5552

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BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,406

Applicant(s)

YOSHIE, NAOKI

Examiner

Bruce H. Hess

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11-20-03 (Procl. Amdt.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2-4-04 and 4-1-04</u> | 6) <input type="checkbox"/> Other: _____  |

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Kohno et al. (EP 0 601 502), Mitsuhashi et al. (EP 0 695 789) or Murakami et al. (JP 07-311523) in view of the patent to Eid et al. (WO 90/16016).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Kohno et al. (EP 0 601 502), Mitsuhashi et al. (EP 0 695 789) or Murakami et al. (JP 07-311523) in view of the patent to Fryberg et al. (USP 5,916,673).

The primary references teach methods of removing printed material on ink jet recording media. Printed ink jet recording media having a base layer and a water-swelling surface layer are brought into contact with a surface layer-swelling solvent which swells the surface of the recording media followed by the removal of the printing by applying a physical force. The recording layers can comprise cross-linked water-soluble resins having fine particles dispersed therein. The secondary references teach the advantages (e.g., smooth coatings of even thickness) of adding surfactants to ink jet recording layers. Fryberg et al. additionally teach applicants' surfactants of formulae (i) – (vii). Use of the surfactants of the secondary references for concomitant function in the recording layers of the primary references would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

The pertinent portions of the cited references are:

Kohno et al. (page 3, lines 5 and 18 et seq.)

Mitsuhashi et al. (page 2, line 15 and page 4, lines 5-19)

Murakami et al. (page 3 of the translation)

Eid et al. ( see the Abstract)

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Fryberg et al. (column 6, line 46 et seq.)

A handwritten signature in black ink, appearing to read "Bruce Hess". The signature is fluid and cursive, with the first name "Bruce" and the last name "Hess" clearly distinguishable.

**BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300**